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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/504,236	02/15/2000	Swain W. Porter	112076-138321	7611
25943 7590 10/30/2008 SCHWABE, WILLIAMSON & WYATT, P.C. PACWEST CENTER, SUITE 1900 1211 SW FIFTH AVENUE PORTLAND, OR 97204				
EXAMINER				
SHINGLES, KRISTIE D				
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2441				
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10/30/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/504,236

Applicant(s)

PORTER, SWAIN W.

Examiner

KRISTIE D. SHINGLES

Art Unit

2441

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 12-20, 24, 26-29, 31-38, 41-46 and 48-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24, 26, 27, 41-46, 48, 49, 56-61 and 67-71 is/are allowed.
- 6) ☒ Claim(s) 1-5, 12-20, 28-29, 31-38, 50-55 and 62 is/are rejected.
- 7) ☐ Claim(s) 6 and 63-66 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-6, 12-20, 24, 26-29, 31-38, 41-46 and 48-71 are pending.
Claims 7-11, 21-23, 25, 30, 39, 40 and 47 are cancelled.

In light of Applicant's Appeal Brief filed 8/12/2008
Claims 1-5, 12-20, 28-29, 31-38, 50-55 and 62 are rejected.
Claims 6 and 63-66 are objected.

Claims 24, 26-27, 41-46, 48-49, 56-61 and 67-71 are allowed.

Response to Arguments

I. In view of the Appeal Brief filed on 8/12/2008, PROSECUTION IS HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is a non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendment, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Allowable Subject Matter & Reasons for Allowance

II. Claims 24, 26-27, 41-46, 48-49, 56-61 and 67-71 are allowed.

In light of the arguments presented in the Appeal Brief on 8/12/2008, the above claims are allowed over the prior art. The prior art fails to teach or suggest the features of providing separate and distinct email addresses (or a collection of email addresses) by the email provider in advance of or in real time to the user employing the addresses for respective intended versus unintended communication partners as disclosed in the above claims (for support, see Specification pages 11-14). The prior art does not specifically teach these limitations singly or in combination such that the claimed invention would have been anticipated or made obvious to one of ordinary skill in the art. Applicant's arguments further clarify the distinctions between the claim language and the prior art and are thus relied upon by the Examiner as sufficient reasons for allowance, satisfying the record as whole as required by rule 37 CFR 1.104 (c) (see MPEP 13202.14).

Any comments considered necessary by Applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

III. Claims 6 and 63-66 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

- **Claim 6** (which includes the independent claim 1 and intervening 5) recites the allowable subject matter discussed above and thus overcomes the prior art of record.
- **Claims 63-66** (which depends on independent claim 62) recites the allowable subject matter discussed above and thus overcomes the prior art of record.

Claim Rejections - 35 USC § 101 Utility

IV. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

V. Claim 62 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

According to Supreme Court precedent *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876) and recent Federal Circuit decisions, to qualify as statutory, a method claim must positively recite the other statutory class (the thing or product) to which it is tied. In this case, since there is not recitation of the hardware/computer/device that performs the method, the claim is non-statutory. Corrective claim language such as "a computer-implemented method" would comply with the precedent and render the claim statutory under 35 U.S.C. 101.

Claim Rejections - 35 USC § 103

VI. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

VII. Claims 1-5, 15, 16, 20, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Pennell et al* (US 6,874,023) in view of *Winblad* (US 6,205,330).

- a. **Per claim 1**, *Pennell et al* teach a method comprising:
- a user computer providing a first email address received from an email service provider for use to register a user of the user computer with a first web site (*col.1 lines 53-62*); and
 - the user computer providing a second email address received from the email service provider, separate and distinct from the first email address, for use to register said user with a second web site (*col.1 lines 12-15 and 56-61, col.3 lines 24-34*).

Pennell et al teach an email management service that generates a new email address whenever needed or requested by the user (*col.3 lines 1-12 and 35-42, col.4 lines 15-17*), which implies that the new email address is separate and distinct from the email address currently used by the user. *Pennell et al* fail to explicitly teach wherein the first and second email addresses were provided to the user computer by the email service provider in advance of providing the first and second email addresses to the first and second web sites by the user computer. However, *Winbladh* teaches that upon successfully obtaining an email account, a user is sent correspondence including the registered email address and alias addresses for the registered user in advance of using the email and alias addresses (*col.4 lines 54-57, col.8 lines 46-50*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Pennell et al* with *Winbladh* for the purpose of generating first and second (multiple) email addresses to registered users, in order to provide the users with additional email addresses usable for communicating with particular websites or other users from aliased identities which ensures the user's privacy and minimizes unsolicited email communications with the user.

b. **Claim 28** contain limitations that are substantially equivalent to claim 1 and are therefore rejected under the same basis.

c. **Per claim 2**, *Pennell et al* with *Winbladh* teach the method of claim 1, *Winbladh* further teaches wherein the first email address comprises a first user identifier, and the second email address comprises a second user identifier, separate and distinct from said first user identifier (*col.4 lines 54-57, col.8 lines 46-50*).

d. **Claim 4** is substantially similar to claim 2 and is therefore rejected under the same basis.

e. **Per claim 3**, *Pennell et al* with *Winbladh* teach the method of claim 1, *Pennell et al* further teach wherein the first email address comprises an address of the email service provider, and the second email address comprises the address of the same email service provider (*col.3 lines 1-12 and 35-42; Winbladh: col.4 lines 54-57, col.8 lines 46-50*).

f. **Per claim 5**, *Pennell et al* with *Winbladh* teach the method of claim 1, *Winbladh* further teaches wherein said providing of the first and second email addresses by the user computer comprises selecting by said first and second email address from a plurality of distinct email addresses simultaneously provided by said email service provider to said user computer (*col.4 lines 54-57, col.8 lines 46-50*).

g. **Claim 29** is substantially similar to claim 5 and is therefore rejected under the same basis.

h. **Per claim 15**, *Pennell et al* with *Winbladh* teach the method of claim 1, *Pennell et al* further teach wherein the method further comprises: receiving emails addresses to said first

and second email; organizing said received emails based at least in part on whether the emails are addressed to the first of the second email address (*col.4 lines 15-43*).

i. **Per claim 16**, *Pennell et al* teach the method of claim 15, wherein said organizing of said received emails is at least further based on whether said received emails addressed to said first or second email address were sent respectively by said first or second web site or not (*Figure 6, col.3 lines 53-65, col.4 lines 35-43*).

j. **Per claim 20**, *Pennell et al* with *Winbladh* teach the method of claim 1, *Pennell et al* further teach wherein the web site is a content provider, a service provider and an access provider (*col.1 lines 17-31*).

VIII. Claims 12, 17-19, 33-38 and 50-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Pennell et al* (US 6,874,023) in view of *Winbladh* (US 6,205,330) in further view of *Gabber et al* (US 6,591,291).

k. **Per claim 33**, *Pennell et al* and *Winbladh* teach a method comprising: an email service provider receiving emails addressed to a first and second email address of a user, the first and second email addresses being separate and distinct from each other having been provided by the email service provider to an electronic device of the user for the electronic device to facilitate communication between the user and a first intended communication partner using the first email address and to facilitate communication between the user and a second intended communication partner using the second email address (*Pennell et al: col.3 lines 1-65; Winbladh: col.4 lines 54-57, col.8 lines 46-50*).

Pennell et al further teach the email server provider organizing the received emails based on the distinct email addresses of users and allowing for the user to designate which

are wanted or unwanted (*Figure 6, col.3 lines 53-65, col.4 lines 35-43*); yet *Pennell et al* and *Winbladh* fail to explicitly teach the email server provider organizing said received emails based at least in part on said first and second email addresses of the user, and respective intended versus unintended communication partners of said first and second email addresses of the user. However *Gabber et al* teach organizing and filtering of reply emails based the alias source address, wherein the alias source address depends on the destination address in order to identify which alias addresses are reject alias source addresses—if the reply email contains a reject alias source address then the reply message is deleted (*Abstract, col.3 lines 20-44, col.8 lines 5-18 and 27-66*). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Pennell et al* and *Winbladh* with *Gabber et al* for the purpose of organizing email messages according to the user's different email addresses and presenting the email messages of interest to the user, wherein the user can bypass reading messages from parties of no interest. This also provides users an effective way to determine where junk email purveyors obtained the user's alias source address.

l. **Claims 17, 35, 36, 50, 52 and 53** contain limitations that are substantially equivalent to claim 33 are therefore rejected under the same basis.

m. **Per claim 34**, *Pennell et al* and *Winbladh* with *Gabber et al* teach the method of claim 33, *Pennell et al* wherein said organizing of said received emails is at least further based on whether said received emails addressed to said first or second email address were sent respectively by said first or second web site or not (*Figure 6, col.3 lines 53-65, col.4 lines 35-43; Gabber et al: col.8 lines 56-66*).

n. **Claim 51** is substantially equivalent to claim 34 and is therefore rejected under the same basis.

o. **Per claim 37**, *Pennell et al* and *Winbladh* with *Gabber et al* teach the method of claim 36, *Gabber et al* further teach wherein said deletion is performed in response to user instruction (*col.8 lines 35-37*).

p. **Claims 18 and 54** are substantially similar to claim 37 and are therefore rejected under the same basis.

q. **Per claim 38**, *Gabber et al* teach the method of claim 37, wherein the method further comprises providing the user with an end user interface feature to provide said deletion instruction with a single press of a key or control button (*col.3 lines 26-34, col.8 lines 56-66*).

r. **Claims 19 and 55** are substantially similar to claim 38 and are therefore rejected under the same basis.

s. **Per claim 12**, *Pennell et al* and *Winbladh* with *Gabber et al* teach the method of claim 1, *Gabber et al* further teach wherein the method further comprises: the user computer notifying the email service provider of the usage of the first and second email addresses, including address of the first and the second website (*col.3 lines 35-41, col.8 lines 27-50*).

t. **Claims 13, 14, 31 and 32** are substantially similar to claim 12 and are therefore rejected under the same basis

Conclusion

IX. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie D. Shingles whose telephone number is (571)272-3888. The examiner can normally be reached on Monday 8:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kristie D. Shingles
Examiner
Art Unit 2441

/KDS/

/William C. Vaughn, Jr./

Supervisory Patent Examiner, Art Unit 2444